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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,425	04/02/2004	Robert G. Penlesky	018695-9352-00	1298
23409	7590	10/26/2005		
MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE MILWAUKEE, WI 53202			EXAMINER KING, ANITA M	
			ART UNIT	PAPER NUMBER
			3632	

DATE MAILED: 10/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/817,425

**Applicant(s)**

PENLESKY ET AL.

**Examiner**

Anita M. King

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/11/05</u> . | 6) <input type="checkbox"/> Other: _____  |

cc

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This is the second office action for application number 10/817,425, Fan Mounting Spacer Assembly and Method, filed on April 2, 2004.

### ***Election/Restrictions***

Claims 19-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 18, 2005.

### ***Specification***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Fan Mounting Spacer Assembly.

### ***Cancellation of Claims***

Claims 19-21 have been canceled per applicant's request.

### ***Claim Objections***

Claims 4 and 13 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The subject matter in claims 4 and 13 are drawn to a method of making the body of the spacer,

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whereas the parent claims, claims 1 and 10, are drawn to the structural limitations of the spacer and thus, claims 4 and 13 do not further limit the previous claims from which they depend.

Claims 6 and 15 are objected to because of the following informality: in line 1, "apertures" should be changed to --aperture--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5-11, 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 3,871,723 to Pray. In regards to claims 1, 2, and 5-9, Pray discloses a spacer (1) capable of mounting a fan housing to a surface of a structural support, the spacer comprising: a body; a first aperture (37) passing through the body, the first aperture having a first length through the body; a second aperture (36) passing through the body, the second aperture having a second length through the body, the second length different than the first length; wherein the body has a first orientation (Fig. 6); wherein the body has a second orientation (Fig. 7); a third aperture (55) passing through the body, the third aperture having third length through the body and wherein the body has a third orientation (Fig. 8); wherein the body includes an outwardly extending protrusion/lip (31 or 32) for orientating the spacer; wherein the first aperture

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and second aperture lie in planes that are substantially perpendicular to one another; wherein the body includes a first mounting surface (33) and a second mounting surface (34 or 35), the first mounting surface (33) being substantially perpendicular to the second mounting surface (35); wherein the lip prevents orientation of the spacer in a fourth orientation in which the second mounting surface is flush with the surface of the structural support.

In regards to claims 10, 11 and 14-18, Pray discloses a spacer (1) comprising: a body defining a first aperture (37) and a second aperture (36) extending in different directions through the body, the body positionable in a first orientation and a second orientation; a first mounting surface (12), the first aperture extending through the first mounting surface and dimensioned to receive a fastener; a second mounting surface (33), the second aperture extending through the second mounting surface and dimensioned to receive a fastener; a third aperture (55) extending in a direction through the body different than the directions of the first and second apertures; wherein the body is positionable in a third orientation; the body including a third mounting surface (35), the third aperture extending through the third mounting surface and dimensioned to receive a fastener wherein the body includes an outwardly extending protrusion/lip (32); wherein the first aperture and second aperture lie in planes that are substantially perpendicular to one another; and a second lip (31) extending outwardly from the second mounting surface.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pray in view of U.S. Patent 5,492,032 to Hartman. Pray discloses the claimed invention except for the limitation of the first aperture being tapered. Hartman teaches a mounting bracket having an aperture (34) extending therethrough, wherein the aperture is tapered. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the apertures in Pray to have been tapered as taught by Hartman for the purpose of providing a means for easing the insertion of a fastener within the aperture.

Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pray. Pray discloses the claimed invention except for the limitation of the body being made from an injection mold and the apertures being formed during molding. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the spacer in Pray to have been manufactured by a molding process since such a modification is known in the art and since such a modification would not have produced any unexpected results.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 3,353,570 to Sweat

U.S. Patent 5,544,865 to Abbaticchio

U.S. Patent 5,878,985 to Iannone

U.S. Patent 5,947,652 to Wagner

U.S. Patent Application Publication 2005/0036829 to Trull


Sweat discloses a connector having a plurality of apertures. Abbaticchio discloses a support rail having a support disc with a plurality of apertures. Iannone discloses a shim. Wagner discloses a spacer block having a plurality of apertures. Trull discloses a connector block including a plurality of apertures.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita M. King whose telephone number is (571) 272-6817. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Anita M. King  
Primary Examiner  
Art Unit 3632

October 24, 2005